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| 09/926,496 | 01/25/2002 | David Leslie Mcneight | P67280US0 | 6657 |
| 136 | 7590 | 03/16/2004 | EXAMINER | |
| JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004 | | | GHALI, ISIS A D | |
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| | | | 1615 | |

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|----------------------------------------|--|
| Office Action Summary | Application No. 09/926,496 | Applicant(s) MCNEIGHT, DAVID LESLIE | |
| | Examiner Isis Ghali | Art Unit. 1615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The receipt is acknowledged of applicant's amendment, drawings and request for extension of time, all filed 12/04/2003.

Claims 2 and 3 have been cancelled, and claims 1, 4-16 are included in the prosecution.

The following new ground of rejection is necessitated by applicant's amendment:

Claim Rejections - 35 USC § 103

1. Claims 1, 4, 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '906 in view of US 5,830,463 ('463).

GB '906 discloses a controlled release composition of active agents include nicotine provided in controlled release transdermal or oral devices, such devices read on the solid carrier of claim 5 and the patch of claim 16 (abstract; page 2, lines 69-75; page 5, lines 8-11, 18-19). The active agent is contained in plurality of microcapsules that distributed throughout the delivery device, and delivered continuously from the microcapsules to the skin or mucosa (page 2, lines 83-94). The active agent, i.e. nicotine, is administered from a suitable device in any convenient and appropriate form

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(page 3, lines 3-5). The solid active agent is delivered with a solvent, i.e. diluent (page 3, lines 5-10). The release of the active agent upon contact of the microcapsules with a nicotine solvent, as well as the limitation of claim 2 are related to the intended mechanism of action upon use of the delivery system, and not to the delivery system *per se*, and the mechanism of action of the encapsulated nicotine is inherent in the encapsulated nicotine of the prior art.

GB '906, however, does not teach that the microcapsules comprise yeast cells or the system comprising mixture of cells charged with nicotine and diluent-empty cells.

US '463 teaches yeast vehicle used for drug delivery (abstract). The yeast cells are safe and do not cause significant side effects (col.4, line 57; col.5, lines 35-36). The yeast vehicle carries the drug within the yeast periplasm, i.e. the drug inside the yeast cell that encapsulates the drug, or the yeast cell carries the drug on the membrane, i.e. the yeast cell itself is empty, and combination thereof (col.5, lines 1-4; col.6, lines 14-36). The yeast delivery vehicle is used for solid oral or transdermal controlled release formulations (col.18, lines 5-6, 24-25, 54-55, 63-66; col.19, lines 1-3).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to obtain a controlled release delivery system comprising encapsulated nicotine as taught by GB '906, and replace microcapsules that encapsulate the nicotine and the solvent by the yeast cells as taught by US '463, motivated by the teaching of US '463 that the yeast cells are safe and do not cause significant side effects, with reasonable expectation of having a delivery system

comprising encapsulated nicotine with the capsules comprising yeast cells that deliver nicotine safely at controlled release rate to the subject in need with minimal side effects.

2. Claims 1, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '334 in view of US '463.

US '334 discloses a nicotine containing dosage form for controlled release of nicotine comprising microencapsulated nicotine within a barrier capable of releasing the nicotine for transmucosal administration, the barrier reads on the solid carrier of claim 5 (abstract; col.9, lines 37-45; col.10, lines 8-10). The release of the active agent upon contact of the microcapsules with a nicotine solvent, as well as the limitation of claim 2 are related to the intended mechanism of action upon use of the delivery system, and not to the delivery system *per se*, and the mechanism of action of the encapsulated nicotine is inherent in the encapsulated nicotine of the prior art.

US '334, however, the does not teach that the microcapsules comprises yeast cells or the system comprising mixture of cells charged with nicotine and diluent-empty cells.

US '463 teaches yeast vehicle used for drug delivery (abstract). The yeast cells are safe and do not cause significant side effects (col.4, line 57; col.5, lines 35-36). The yeast vehicle carries the drug within the yeast periplasm, i.e. the drug inside the yeast cell that encapsulates the drug, or the yeast cell carries the drug on the membrane, i.e. the yeast cell itself is empty, and combination thereof (col.5, lines 1-4; col.6, lines 14-

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36). The yeast delivery vehicle is used for solid oral or transdermal controlled release formulations (col.18, lines 5-6, 24-25, 54-55, 63-66; col.19, lines 1-3).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to obtain a controlled release delivery system comprising encapsulated nicotine as taught by US '334, and replace the encapsulating material that encapsulate nicotine and the excipient by the yeast cells as taught by US '463, motivated by the teaching of US '463 that the yeast cells are safe and do not cause significant side effects, with reasonable expectation of having a delivery system comprising encapsulated nicotine with the capsules comprising yeast cells that deliver nicotine safely at controlled release rate to the subject in need with minimal side effects.

3. Claims 6-9, 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '906 in view of US '463 and further in view of US 5,733,574 ('574).

Claims 6-9 recite the delivery system as lozenge comprising sugar; and the delivery system further comprising flavoring agent (claim 12) and vitamin (claim 14), and claims 13 and 15 recite that the flavoring agent and the vitamin are encapsulated.

GB '906 disclosed a controlled release composition of active agents include nicotine provided in controlled release transdermal or oral devices, such devices read on the solid carrier of claim 5 and the patch of claim 16 (abstract; page 2, lines 69-75; page 5, lines 8-11, 18-19). The active agent is contained in plurality of microcapsules that distributed throughout the delivery device, and delivered continuously from the microcapsules to the skin or mucosa (page 2, lines 83-94). The active agent, i.e.

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nicotine, is administered from a suitable device in any convenient and appropriate form (page 3, lines 3-5). The solid active agent is delivered with a solvent, i.e. diluent (page 3, lines 5-10).

GB '906 does not teach the delivery system as a lozenge comprising sugar as claimed in claims 6-9, or the delivery system comprises flavoring agent and supplemental vitamin or the encapsulation of the flavoring agent and the vitamin as claimed in claims 12-15.

US '574 teaches a saliva soluble delivery unit for oral use that provides a controlled release of nicotine in the form of lozenge (abstract; col.3, lines 10-16; col.9, lines 34-35, 44, 48). The saliva soluble delivery unit comprising nicotine, sugar, flavoring agent, and vitamins because smokers usually lose vitamins and some vitamins act as stabilizing agents (col.7, lines 58-62; col.8, lines 31-34, 51-64). The reference teaches that the nicotine delivery unit provides a nicotine dose corresponding to the stimulation of nicotine obtained by smoking a cigarette (col.3, lines 30-34; col.5, lines 31-33). The reference also disclosed that the flavor could be tobacco flavor that is provided from smokeless nicotine and does not contribute significantly to the level of nicotine (col.3, lines 34-36; col.8, lines 31-34).

One having ordinary skill in the art would have encapsulated the flavoring agents and the vitamins for the same reason the active ingredient has been encapsulated by GB '906, i.e. providing continuous controlled release of the encapsulated agents.

In order to have the delivery of nicotine that provide a particular blood concentration in a certain period of time, one having ordinary skill in the art would have

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been expected to adjust the oral delivery unit regarding its size, solubility and charge of nicotine to obtain the desired blood concentration in the desired time. Applicant is not claiming any particular amount of nicotine in the cigarette nor the desired blood level that needed to be achieved.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to obtain a controlled release delivery system comprising encapsulated nicotine as taught by GB '906 in the form of lozenge that comprises sugar vitamins and flavoring agent as disclosed by US '574, motivated by the teaching of US '574 that the delivery units in form of lozenge provide nicotine dose corresponding to the stimulation of nicotine obtained by smoking a cigarette, as desired by applicant, and also one having ordinary skill in the art would have been motivated to add flavoring agent and vitamin to the nicotine lozenge motivated by the teachings of US '574 that the flavor could be tobacco flavor that is provided from smokeless nicotine and does not contribute significantly to the level of nicotine and that smokers usually loose vitamins and some vitamins act as stabilizing agents, with reasonable expectation of having a lozenge that provides nicotine equivalent to that delivered by cigarette in a controlled release manner and meanwhile deliver vitamin supplement all in one delivery system that have an acceptable flavor.

4. Claims 6, 7, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '906 in view of US '463 and further in view of US 6,358,060 ('060).

Claims 6, 7, and 9 recite the delivery system as a lozenge, and claim 11 recites the delivery system as chewing gum.

GB '906 disclosed a controlled release composition of active agents include nicotine provided in controlled release transdermal or oral devices, such devices read on the solid carrier of claim 5 and the patch of claim 16 (abstract; page 2, lines 69-75; page 5, lines 8-11, 18-19). The active agent is contained in plurality of microcapsules that distributed throughout the delivery device, and delivered continuously from the microcapsules to the skin or mucosa (page 2, lines 83-94). The active agent, i.e. nicotine, is administered from a suitable device in any convenient and appropriate form (page 3, lines 3-5). The solid active agent is delivered with a solvent, i.e. diluent (page 3, lines 5-10).

GB '906 does not teach the delivery system as a lozenge as claimed in claims 6, 7, and 9 or chewing gum as claimed in claim 11.

US '060 teaches a delivery system in the form of lozenge or chewing gum to deliver encapsulated nicotine, wherein the delivery system is convenient, reliable, practical and painless (abstract; col.7, lines 10-12, 56-59; col.10, lines 46-47). The delivery system provides amount of nicotine that is absorbed into the blood stream within 5 minutes and provides concentration sufficient to provide craving relief and for 20 minutes (col.8, lines 2-10; col.9, lines 49-61).

In order to have the delivery of nicotine that provide a particular blood concentration in a certain period of time, one having ordinary skill in the art would have been expected to adjust the oral delivery unit regarding its size, solubility and charge of

nicotine to obtain the desired blood concentration in the desired time. Applicant is not claiming any particular amount of nicotine in the cigarette nor the desired blood level that needed to be achieved.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the nicotine oral delivery system of GB '906 in the form of lozenge or chewing gum as disclosed by US '060, motivated by the teaching of US '060 that lozenge and chewing gum are convenient, reliable, practical and painless method to administer nicotine, and lozenge and chewing gums provide amount of nicotine that is absorbed into the blood stream within 5 minutes and provides concentration sufficient to provide craving relief and for 20 minutes, with reasonable expectation of having a lozenge or chewing gum to deliver nicotine in a controlled release manner and also provide craving relief for sufficient time to the subject in need.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB '906 in view of US '463 and US '574 as applied to claims 6-9, 12-15 above or over GB '906 in view of US '463 and US '060 as applied to claims 6,7, 9, and 11 above, and further in view of GB 2 299 756 ('756).

Claim 10 recites the lozenge having 5-20 cm length with preferential snapping positions.

The teachings of GB '906 in view of US '463 and US '574 and GB '906 in view of US '463 and US '060 are discussed above. However, the references in combination do not teach the size or shape of the lozenge delivery system.

GB '756 teaches product in the form of pastille for oral ingestion containing nicotine and flavoring agent, vitamin, and sugar (abstract; page 1, last paragraph; claims 5, 6, 9, 16, 17). The pastille may be of such size and contain as much nicotine as will correspond to the time taken to smoke a cigarette and the amount of nicotine absorbed by the tissue of the buccal cavity during such time (page 3, second full paragraph). The product in the form of rod or bar-like and has zones of weakness allowing it to be broken into smaller pieces, claim 10 (page 3, second full paragraph; claim 14).

The reference implies that the size of the delivery unit is adjustable to such size and contain as much nicotine as will correspond to the time taken to smoke a cigarette and the amount of nicotine absorbed by the tissue of the buccal cavity during such time. Thus, the size of the lozenge as a whole as claimed by applicant does not impart patentability to the claim because what is important is the size and amount of the nicotine in the snapped part that administer the nicotine, and also we do not know how much nicotine in the claimed size or how much blood concentration needed to be achieved, absent evident to the contrary.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to deliver the delivery system in the form of lozenge as taught by GB '906 in view of any of US '574 or US '060 and select the bar-like shape with zones of weakness to break the lozenge as taught by GB '756, motivated by the teaching of GB '756 that the breakable system ease the accommodation in the mouth while providing the requisite dosage of nicotine over the appropriate time, with

reasonable expectation of providing lozenge with preferential snapping positions that accommodate in the mouth and provide the sufficient nicotine level in the blood for the required period of time as a successful smoking substitute.

Response to Arguments

6. Applicant's arguments filed 12/04/2003 have been fully considered but they are not persuasive. The main gist of applicant's argument against the rejection of the claims over GB '906 and US '334 is that the references do not teach the use of yeast cells to encapsulate the nicotine. Applicant's traverse the rejection of the claims over GB '906 and US '334 in view of US '463 by arguing that no motivation to combine GB '906 or US '334 with US '436 because US '436 is directed to modulating the immune response.

In response to the above arguments, the examiner position is that both of the primary references teach the encapsulation of nicotine, but not specifically encapsulation with yeast cells. The secondary reference teaches the encapsulation of drugs in yeast cells because yeast cells are safe and do not cause significant side effects. Thus, it would have been obvious to one having ordinary skill in the art to encapsulate drugs to be delivered to patient in a yeast cells based on the safety of the delivered formulation. In considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational

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may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. Furthermore, one cannot show nonobviousness by attacking the references individually where the rejections are based on combination of references. See *In re Keller*, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching of US '436 that yeast cells are safe and do not cause serious side effects would motivate encapsulating nicotine into yeast cells.

Applicant has failed to traverse the rejection of claims 6-9, 12-15 under 35 U.S.C. 103(a) as being unpatentable over GB '906 in view of US '463 and further in view of US 5,733,574 ('574); the rejection of claims 6, 7, 9, 11 under 35 U.S.C. 103(a) as being unpatentable over GB '906 in view of US '463 and further in view of US 6,358,060 ('060); and the rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over GB '906 in view of US '463 and US '574 as applied to claims 6-9, 12-15 above or over GB '906 in view of US '463 and US '060 as applied to claims 6, 7, 9, and 11 above, and further in view of GB 2 299 756 ('756), the response is considered to be acquiescence

to the position taken by the examiner. The rejection is therefore repeated for reasons of record. See MPEP 37 CFR 1.111 (b).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali
Examiner
Art Unit 1615


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600